

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN H. GILLESPIE

Appeal No. 2005-1051
Application No. 09/788,147

ON BRIEF

Before MCQUADE, NASE, and BAHR, Administrative Patent Judges.
Per curiam.

DECISION ON APPEAL

Kevin H. Gillespie appeals from the final rejection (mailed May 28, 2003) of claims 1 through 15, 17 through 23 and 26 through 29, all of the claims pending in the application.¹

THE INVENTION

The invention relates to "a shoe outsole and, in particular, to a shoe outsole for a toddler shoe having an improved cushioning system at the heel" (specification, page 1).

¹Claims 1, 11, 22 and 26 have been amended subsequent to final rejection.

Representative claim 1 reads as follows:

1. A shoe comprising:
an outsole having an upper surface, an opposite lower surface, and a heel section, the upper surface being positioned relatively closer to a wearer's foot and the lower surface being positioned to engage upon a floor or ground surface when the shoe is worn during walking, the outsole further defining an aperture in the heel section extending from the upper surface to the opposite lower surface; and
a resilient, deformable first cushion disposed in said aperture, with an upper cushion surface of said first cushion disposed at a region of the upper surface of the outsole in the heel section and a lower cushion surface of said first cushion exposed at a region of the lower surface of the outsole in the heel section,
said first cushion being adapted to deform and flow toward the floor or ground surface under the wearer's weight and force of heel strike, and
the outsole further comprising a recessed wall surface extending generally upwards from the lower surface toward the upper surface and defining a recessed region in communication, at its upper reaches, with said aperture, said lower cushion surface of said first cushion, exposed at the aperture within said recessed region, being spaced by said recessed wall surface of said outsole above the floor or ground surface at all times, including when said first cushion deforms and flows under the wearer's weight and force of heel strike.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Duclos	4,724,624	Feb. 16, 1988
Fuerst	4,897,936	Feb. 06, 1990
Preston	5,287,638	Feb. 22, 1994
Dyer et al. (Dyer)	5,325,611	Jul. 05, 1994

Parisotto	5,768,806	Jun. 23, 1998
Pavone	6,009,637	Jan. 04, 2000
Schenkel, Brazilian Patent Document ²	9800597-9	Nov. 30, 1999

THE REJECTIONS

Claims 1 through 6, 8, 11, 13 through 15, 17, 22, 23 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schenkel.

Claims 1, 4 through 6, 11, 12, 15, 17 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fuerst.

Claims 1 through 4, 11, 15 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Preston in view of Fuerst.

Claims 1 and 5 through 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Duclos in view of Fuerst.

Claims 1 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parisotto in view of Fuerst.

²Our understanding of the Brazilian document stems from U.S. Patent No. 6,418,641 to Schenkel which is an English language equivalent. Consistent with the arguments advanced by both the appellant and the examiner, our discussion of the Brazilian document will be in terms of the U.S. patent which is itself prior art to the appellant's invention under 35 U.S.C. § 102(e).

Claims 1, 5, 6, 11 and 13 through 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dyer in view of Fuerst.

Claims 1, 3, 4, 12, 15, 17 through 23 and 27 through 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pavone in view of Fuerst.

Attention is directed to the main and reply briefs (filed Jan. 20, 2004 and April 2, 2004) and the answer (mailed Feb. 20, 2004) for the respective positions of the appellant and examiner regarding the merits of these rejections.³

DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claims 1 through 6, 8, 11, 13 through 15, 17, 22, 23 and 26 as being anticipated by Schenkel

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444,

³ In the final rejection, claims 1 through 15, 17 through 23 and 26 through 29 also stood rejected under 35 U.S.C. § 112, second paragraph. Upon reconsideration, the examiner has withdrawn this rejection (see page 7 in the answer).

221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Schenkel discloses a shoe 10 comprising an upper 12 and a frame system 14 consisting of an insole 16, a frame 18 and a sole 20 having separate parts 22, 24 and 26. The frame 18 includes first and second cutouts 28 and 30, and sole parts 24 and 22 include respective cutouts 32 and 34 aligned with the cutouts in the frame. In use, the insole 16, which is made of a resilient material having shock-absorbing characteristics (see column 4, lines 15 through 23), protrudes or bulges downwardly through the cutouts in the frame under the compressive forces applied by the user's foot (see column 2, line 66, through column 3, line 16).

As framed and argued by the appellant, the dispositive issue with respect to the rejection of independent claim 1 is whether Schenkel meets the limitations in the claim requiring (1) the first cushion to "deform and flow" toward the floor or ground

surface under the wearer's weight and force of heel strike and (2) the lower surface of the cushion to be spaced by the recessed wall surface of the outsole "above the floor or ground surface at all times" including when the cushion deforms and flows under the wearer's weight and force of heel strike.

The examiner's finding that Schenkel's insole 16 constitutes a first cushion meeting these argued limitations is well taken.

While it is not disputed that the Schenkel insole 16 will "deform" as recited in claim 1, the appellant contends that the insole will not "flow" and that the examiner's interpretation of "flow" as meaning "to deform under stress without cracking or rupturing" is improper:

[t]his use of the term "flow" is clearly inconsistent with the manner in which this term is used in Applicant's specification, to refer to soft gelatinous materials. A more appropriate definition is . . . "to move with a continual change of place among the constituent particles <the molasses *flowed* smoothly>." When the term "flow" is defined appropriately in light of Applicant's specification and its common meaning, it is clear that the Schenkel insole cannot fairly be said to flow [main brief, page 6].⁴

During patent examination claims are to be given their broadest reasonable interpretation consistent with the underlying

⁴The appellant and examiner refer to an unspecified version of "Webster's Dictionary" for their respective definitions of "flow."

specification without reading limitations from the specification into the claims. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). Even under the definition of "flow" advanced by the appellant, Schenkel's resilient and shock-absorbing insole 16 will deform and "flow" toward the floor or ground surface under the wearer's weight and force of heel strike as recited in claim 1 when the forces applied by the user's foot cause it to compress and bulge downwardly through the cutouts in the frame. The appellant's attempt to equate the claimed "flow" to that of a gelatinous material is an improper reading of limitations from the specification into the claim. Furthermore, Schenkel's Figures 6 and 8, which show the insole 16 acted upon by the forces applied by a foot, provide a reasonable basis for the examiner's determination that the lower surface of the insole or cushion will be spaced by the recessed wall surface of the outsole "above the floor or ground surface at all times" including when the cushion deforms and flows under the wearer's weight and force of heel strike. Hence, the appellant's position that the subject matter set forth in claim 1 distinguishes over that disclosed by Schenkel is not persuasive.

Accordingly, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Schenkel.

We also shall sustain the standing 35 U.S.C. § 102(b) rejection of dependent claims 2 through 6, 8, 11, 13 through 15 and 17 as being anticipated by Schenkel since the appellant has not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claim 1 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

We shall not sustain, however, the standing 35 U.S.C. § 102(b) rejection of claims 22, 23 and 26 as being anticipated by Schenkel.

Schenkel does not meet the limitations in independent claim 22 (from which claim 23 depends) requiring a cut-out portion in a sidewall of the outsole and a second cushion shaped to deform outwardly at this cut-out portion. The Schenkel reference does not show or describe any such cut-out portion.

Schenkel also fails to meet the limitation in independent claim 26 requiring the first cushion to comprise a polymeric gelatinous material. The examiner's position that Schenkel's cushion or insole 16 is gelatinous merely because it protrudes or

bulges downwardly through the cutouts in the frame 18 is not reasonable.

II. The 35 U.S.C. § 102(b) rejection of claims 1, 4 through 6, 11, 12, 15, 17 and 26 as being anticipated by Fuerst

Fuerst discloses a shoe sole 12 comprising an insole 18, an outsole 16 having openings 28 and 30 at the ball and heel of the foot, a midsole 20 having cavities 46 and 48 aligned with the openings in the outsole, and polyurethane inserts 50 and 52 disposed in the cavities and having dome-shaped portions 58 extending into the openings. Fuerst teaches that

[t]he dome-shaped portion 58 has a height less than the thickness of the outer sole and does not engage the floor or ground until sufficient weight is applied to it by the weight of a player, at which time it will assume the configuration shown in phantom outline in FIG. 5. [column 3, lines 24 through 29].

The foregoing passage belies the examiner's finding that the polyurethane inserts 50 and 52 constitute cushions meeting the recitations in independent claims 1 and 26 of a cushion having a lower surface spaced by the recessed wall surface of the outsole above the floor or ground surface at all times including when the cushion deforms and flows under the wearer's weight and force of heel strike. Fuerst also fails to meet the gelatinous material limitation in claim 26.

Consequently, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claims 1 and 26, and dependent claims 4 through 6, 11, 12, 15 and 17, as being anticipated by Fuerst.

III. The 35 U.S.C. § 103(a) rejection of claims 1 through 4, 11, 15 and 26 as being unpatentable over Preston in view of Fuerst.

For the reasons expressed above, the examiner's reliance on Fuerst to overcome the admitted failure of Preston to respond to the limitations in independent claims 1 and 26 requiring a cushion having a lower surface spaced by the recessed wall surface of the outsole above the floor or ground surface at all times including when the cushion deforms and flows under the wearer's weight and force of heel strike⁵ is unsound. The combined teachings of Preston and Fuerst also lack response to the gelatinous material limitation in claim 26.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1 and 26, and dependent claims 2 through 4, 11 and 15, as being unpatentable over Preston in view of Fuerst.

⁵Preston expressly teaches that the lower surface 25 of shock absorber body or cushion 23 contacts the walking surface when the weight of the body is applied thereto (see column 2, lines 30 through 53).

IV. The 35 U.S.C. § 103(a) rejection of claims 1 and 5 through 9 as being unpatentable over Duclos in view of Fuerst

For the reasons expressed above, the examiner's reliance on Fuerst to overcome the admitted failure of Duclos to respond to the limitations in independent claim 1 requiring a cushion having a lower surface spaced by the recessed wall surface of the outsole above the floor or ground surface at all times including when the cushion deforms and flows under the wearer's weight and force of heel strike is unsound.

Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claim 1, and dependent claims 5 through 9, as being unpatentable over Duclos in view of Fuerst.

V. The 35 U.S.C. § 103(a) rejection of claims 1 and 10 as being unpatentable over Parisotto in view of Fuerst

For the reasons expressed above, the examiner's reliance on Fuerst to overcome the admitted failure of Parisotto to respond to the limitations in independent claim 1 requiring a cushion having a lower surface spaced by the recessed wall surface of the outsole above the floor or ground surface at all times including when the cushion deforms and flows under the wearer's weight and force of heel strike is unsound.

Consequently, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claim 1, and dependent claim 10, as being unpatentable over Parisotto in view of Fuerst.

VI. The 35 U.S.C. § 103(a) rejection of claims 1, 5, 6, 11 and 13 through 15 as being unpatentable over Dyer in view of Fuerst

The only suggestion for modifying the outsole disclosed by Dyer in view of Fuerst to overcome the admitted failure of Dyer to respond to the limitations in independent claim 1 requiring a recessed wall surface and recessed region in the outsole stems from hindsight knowledge impermissibly derived from the appellant's disclosure.

Therefore, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, and dependent claims 5, 6, 11 and 13 through 15, as being unpatentable over Dyer in view of Fuerst.

VII. The 35 U.S.C. § 103(a) rejection of claims 1, 3, 4, 12, 15, 17 through 23 and 27 through 29 as being unpatentable over Pavone in view of Fuerst

The only suggestion for modifying the outsole disclosed by Pavone in view of Fuerst to overcome the admitted failure of Pavone to respond to the limitations in independent claims 1, 22 and 26 (from which claims 27 through 29 depend) requiring a recessed wall surface and recessed region in the outsole stems

from hindsight knowledge impermissibly derived from the appellant's disclosure. The combined teachings of Pavone and Fuerst also lack response to the sidewall cut-out portion limitations in claim 22 and the gelatinous material limitation in claim 26.

Thus, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1 and 22, and dependent claims 3, 4, 12, 15, 17 through 21, 23 and 27 through 29, as being unpatentable over Dyer in view of Fuerst.

Summary

The decision of the examiner:

a) to reject claims 1 through 6, 8, 11, 13 through 15, 17, 22, 23 and 26 under 35 U.S.C. § 102(b) as being anticipated by Schenkel is affirmed with respect to claims 1 through 6, 8, 11, 13 through 15 and 17, and reversed with respect to claims 22, 23 and 26;

b) to reject claims 1, 4 through 6, 11, 12, 15, 17 and 26 under 35 U.S.C. § 102(b) as being anticipated by Fuerst is reversed;

c) to reject claims 1 through 4, 11, 15 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Preston in view of Fuerst is reversed;


d) to reject claims 1 and 5 through 9 under 35 U.S.C. § 103(a) as being unpatentable over Duclos in view of Fuerst is reversed;

e) to reject claims 1 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Parisotto in view of Fuerst is reversed;

f) to reject claims 1, 5, 6, 11 and 13 through 15 under 35 U.S.C. § 103(a) as being unpatentable over Dyer in view of Fuerst is reversed; and

g) to reject claims 1, 3, 4, 12, 15, 17 through 23 and 27 through 29 under 35 U.S.C. § 103(a) as being unpatentable over Pavone in view of Fuerst is reversed.

AFFIRMED-IN-PART


JENNIFER D. BAHR
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Appeal No. 2005-1051
Application No. 09/788,147

Page 16

FISH & RICHARDSON, P.C.
225 FRANKLIN STREET
BOSTON, MA 02110